

**REMARKS**

**I. STATUS OF CLAIMS**

Claim 27 is currently pending. Claim 27 is amended to further clarify the description of the film-forming polymer (B). Support for such an amendment can at least be found in previously presented claim 46 and in the specification, for example on pages 15 and 16. Accordingly, no new matter is added by the that amendment to the claim.

**II. REJECTIONS UNDER 35 U.S.C. § 103**

**A. Bhatt in view of Ramin and Mougín**

The Office has maintained the rejection of claim 27 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,106,808 to Bhatt et al. ("Bhatt") in view of U.S. Patent No. 5,683,681 to Ramin et al. ("Ramin"), and WO 97/25021 to Mougín et al. ("Mougín")<sup>1</sup>. Office Action at page 2. In response to Applicant's arguments, the Office responds by reiterating the alleged motivation to combine Bhatt with Mougín. *Id.* at pages 5 and 6. In addition, the Office highlights that the disclosed multi-blocked copolymer of Mougín overcomes the deficiencies of pure silicone polymers that are provided in Bhatt and as such, the teachings of Bhatt and Mougín do not contradict one another. *Id.* at page 6. Applicant continues to respectfully disagree and traverses the rejection for the reasons of record and for the additional reasons below.

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<sup>1</sup> Reference is made in this response to U.S. Patent No. 6,395,265, which is the English language equivalent for this Mougín reference.

Based on the Office's rationale, Bhatt discloses compositions of (A) polyurethane resin and (B) at least one film-forming polymer, i.e., a second hair fixative resin such as Gantrez A425, and that these compositions provide spray particle sizes of about 20 to about 150 microns. Office Action at pages 2 and 3. The Office then uses Ramin to teach that "butyl esters of vinylmethylether/maleic anhydride copolymers are film-forming polymers" (i.e., Gantrez A425 is known as a film-forming polymer) and Mougin to teach block copolymers of polyurethane and polysiloxane to meet the claimed phrase "wherein the at least one polycondensate (A) is formed from at least one compound having a silicone skeleton . . . ." However, Applicant takes issue with the combination of Bhatt and Mougin.

As highlighted in the present Office Action, "[i]t is noted that the multi-blocked copolymer disclosed by Mougin overcomes the disadvantage of pure silicone polymers and are particularly useful in various hair products . . . ." Office Action at page 6. But, Bhatt's general disclosure of "silicone" is not enough to provide a teaching, suggestion or motivation to combine with Mougin, and certainly not to arrive at the claimed invention.

At best, the teachings of Bhatt and Mougin evidence that the individual ingredients of the claimed invention were known in the prior art. However, such knowledge in the prior art of the individual ingredients is not sufficient alone to establish a *prima facie* case of obviousness. For example, the Federal Circuit in *In re Kotzab*, 217 F.3d 1365, 136-70, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) explained that

Most if not all inventions arise from a combination of old elements . . . However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.

Here, Bhatt makes an ambiguous statement to the inclusion of “silicones” as one of the many possible “additives” that are used in “conventional hair spray adjuvants.” Bhatt at Col. 14, ll. 17-26. Without more, the disclosure in Bhatt directed to “additives” is not enough to lead one skilled in the art to substitute Mougin’s polycondensate that includes a silicone chain, i.e., a polycondensate block with the polyurethane and/or polyurea block.

While Bhatt teaches that the polyurethane resin can comprise various reaction components, silicones are not among the suggested components. *Id.* at Col. 7, line 23-Col. 11, line 34. Instead, Bhatt’s disclosure of “silicone” is with respect to its use as an “additive” or “adjuvant,” not as part of the polyurethane resin polymer. It is unclear how one skilled in the art would take a teaching of an additive or adjuvant and utilize it as part of a complex polymer. Moreover, Mougin says nothing about the deficiencies in Bhatt’s polyurethane polymer and in fact, state the opposite, i.e., Mougin highlights the deficiencies of silicone polymers. Mougin at Col. 1, line 9-Col. 3, line 2. Thus, without more guidance, there is no suggestion or teaching from either Bhatt or Mougin to support their combination.

Assuming, for the sake of argument only, that Mougin does describe the use of silicone polymers, Mougin fails to teach or suggest the particular anionic film-forming polymers now recited in amended claim 27.

For at least these additional reasons, the Office fails to establish a *prima facie* case of obviousness and as such, Applicant respectfully request the withdrawal of the rejection.

**B. Mougin in view of Bhatt and Malawer**

The Office has also maintained the rejection of claim 27 under 35 U.S.C. § 103(a) as unpatentable over Mougin in further view of Bhatt and U.S. Patent No. 5,458,871 to Malawer et al. ("Malawer"). Office Action at page 4. In response to Applicant's arguments, the Office highlights that Mougin's teachings are directed to the use of both copolymers of polyurethane and polysiloxane or an additive to a film-forming agent. Applicant respectfully disagrees and traverses this rejection for the following reasons.

As stated, the process recited in amended claim 27 describes the film-forming polymer as being chosen from anionic film-forming polymers neither taught nor suggested in the prior art. Since the Office relies upon the teaching of Mougin for the "at least one film-forming polymer (B)" and Mougin fails to teach or suggest those particular anionic film-forming polymers recited in amended claim 27, a *prima facie* case of obviousness has not been established, i.e., the cited combination fails to teach all the claim elements. See M.P.E.P. § 2143.

In fact, Mougin merely teaches that the disclosed polycondensates can be used as a film-forming agent or alternatively, as an additive to a film-forming agent. See, e.g., claim 54. The Office even admits that teaching in Mougin. Office Action at pages 4 and 5; 7 and 8. As for Bhatt and Malawer, these secondary references are used to teach the particle size of the droplets and/or the preference for a small particle size of such droplets. Office Action at pages 4 and 5; 7 and 8. Applicant even asked the Office in the Response filed on August 8, 2006, for clarity as to which of the cited references taught the “at least one film-forming polymer (B)” to which the Office responded “Applicant’s attention is directed to Mougin.” Office Action at page 7. Without such a teaching, the combination of cited references is deficient in, *inter alia*, teaching the recited film-forming polymers.

For at least the reasons provided above, the Office fails to establish a prima facie case of obviousness based on the combination of Mougin in view of Bhatt and Malawer. Accordingly, Applicant respectfully requests that the rejection should be withdrawn.

### **III. CONCLUSION**

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claim 27 in condition for allowance. Applicant submits that the proposed amendment of claim 27 does not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.


In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is not rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

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By:   
Adriana L. Burgy  
Reg. No. 48,564